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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,703	02/09/2001	Rudolf Lucas	2551-55	6732

7590 02/19/2004

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EXAMINER

O HARA, EILEEN B

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 02/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/779,703

Applicant(s)

LUCAS ET AL.

Examiner

Eileen O'Hara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,10 and 19-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,10 and 19-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/9/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. Claims 1, 10 and 19-28 are pending in the instant application. Claims 19 and 20 have been amended as requested by Applicant in the Paper filed Dec. 2, 2003..

All claims are currently under examination.

### ***Withdrawn Objections and Rejections***

2. Any objection or rejection of record which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

### ***Information Disclosure Statement***

3. An initialed copy of the PTO-1449 Form filed Feb. 9, 2001 is included with this Office Action as requested by Applicants.

### ***Drawings***

4. The formal drawings filed Feb. 9, 2001, are accepted by the Examiner.

### ***Specification Amendments***

5. In response to Applicants queries about entry of the various amendments, the amendments to the specification filed Dec. 2, 2003 have been entered, including the cross-reference to the parent application. The amendments dated February 9, 2001 were not entered because whole pages would have been substituted. The abstract filed Sept. 25, 2002 has been entered, and is acceptable. However, upon further inspection, it is noted that on page 1, the paragraph after the cross-reference to the parent application, the amino acid sequence

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CGQRETPEGAEAKPWYC does not have a sequence identifier (SEQ ID NO:) identifying it, and the abstract also reciting that sequence does not have a sequence identifier (SEQ ID NO:) identifying it.

Appropriate correction is required.

### ***Double Patenting***

6. The provisional rejection of claims 1 and 10 is maintained under 35 U.S.C. 101 as claiming the same invention as that of claims 3 and 17, respectively of copending Application No. 10/162,553, and the provisional rejection of claims 19-28 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4-16 and 18-30 of copending Application No. 10/162,553, is also maintained, for reasons of record in the previous Office Action, Paper No. 15, at pages 5-6. Applicants have requested that the provisional rejections be held in abeyance until such time as allowable subject matter is indicated. Applicants' request has been fully considered but is not deemed persuasive, and the rejection is maintained.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. The rejection of claims 1, 10, 19-26 and 28 are maintained under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of treating edema with a

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circularized peptide derived from the region of human TNF- $\alpha$  from Ser100 to Glu116 or from the region of mouse TNF- $\alpha$  from Ser99 to Glu115 (17 contiguous amino acids), method of preparing such a medicament comprising such a peptide or a pharmaceutical composition comprising such a peptide for treatment of edema, does not reasonably provide enablement for a non-circularized peptide of 17 amino acids, or a circularized peptide of less than 17 amino acids, for reasons of record in the previous Office Action, Paper No. 15, at pages 7-12.

Applicants have presented in the attached Annex experimental data supporting the efficacy of the smaller Sip peptide and non-circularized peptide in treating oedema. The data would be convincing, however, such data cannot be considered unless presented as a declaration under 35 U.S.C. § 1.132. When any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section. See M.P.E.P. 716.02(g) Declaration or Affidavit Form

“The reason for requiring evidence in declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 25 and 18 U.S.C. 1001.” Permitting a publication to substitute for expert testimony would circumvent the guarantees built into the statute. *Ex parte Gray*, 10 USPQ2d 1922, 1928 (Bd. Pat. App. & Inter. 1989). Publications may, however, be evidence of the facts in issue and should be considered to the extent that they are probative.

It is believed that all pertinent arguments have been answered.

***Conclusion***

8. No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (571) 272-0878. The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (571) 272-0871.

Official papers Before Final filed by RightFax should be directed to (703) 872-9306.

Official papers After Final filed by RightFax should be directed to (703) 872-9307.

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Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Eileen B. O'Hara, Ph.D.

Patent Examiner

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Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Eileen B. O'Hara, Ph.D.

Patent Examiner



LORRAINE SPECTOR  
PRIMARY EXAMINER